

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1, 2, 4, 5, 8, 11, 12 and 80-83 are pending in the application, with 1 and 11 being the independent claims. Claims 3, 6, 7, 9, 10 and 13-79 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. New claims 80-83 were added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 102

Claims 1-5, 11 and 12 are rejected under 35 U.S.C § 102 (a), (b), and/or (e) based on public use or sale of the invention and the Applicant's knowledge of references recited in the information disclosure statement of July 27, 2004.

The Examiner alleges that:

applicants state in their information disclosure statement filed July 27, 2004 that the claimed hydrazides were available from one or more commercial suppliers or were otherwise known prior to Applicants' priority application.

(Office action page 3, lines 11-13). The Examiner further states that the reference specifically discloses the first two compounds recited in claim 11. Applicants respectfully traverse this rejection.

Claim 3 is canceled.

In the prior art compounds, the phenyl group corresponding to Ar₃ of compound V is unsubstituted. Moreover, the positions corresponding to R₃-R₇ substituents of compound V are either all hydrogen atoms or one or two of the substituents are NH₂, NHCH₃, NO₂, Cl or CF₃. In the claimed compounds, when Ar₃ is unsubstituted, R₃-R₇ are not NH₂, NHCH₃, NO₂, halo or CF₃. Thus, the genus of compounds in claims 1 does not encompass any of the commercially available hydrazide compounds. In addition, claims 2, 4, 5 and 8 depend directly or ultimately from claim 1 and can not encompass more than what claim 1 does. Therefore, claims 1, 2, 4, 5 and 8 are not anticipated by the commercially available compounds.

Furthermore, amended claim 11 does not recite any compound disclosed in the prior art. Therefore, claims 11 and 12 are not anticipated by the commercially available hydrazide compounds.

Reconsideration and withdrawal of the rejection of claims 1, 2, 4, 5, 8, 11 and 12 under 35 U.S.C § 102 (a), (b) and/or (e) is respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 1-5, 8, 11 and 12 are rejected under 35 U.S.C § 103 (a) as unpatentable over Applicants' admissions in the information disclosure statement filed July 27, 2004. The Examiner alleges that the claimed compounds are known and/or are commercially available in the prior art. The Examiner asserts that claimed compounds are *prima facie* obvious because they are embraced by the disclosed formula. The Examiner states that:

[t]he instant compounds are known and are commercially available in the prior art. The compounds are specifically listed in claim 11.

(Office Action page 4, lines 7-8). The Examiner further alleges that

the instant compounds differ from the commercially available compounds herein as *halogen analogs and position isomers*. For example, 2-NO₂ and 6-NO₂ are merely position isomers of the known 4-NO₂ and 5-NO₂ compounds.

(Office Action, page 4, line 9-11). Emphasis added. Applicants respectfully traverse this rejection.

Claim 3 is canceled.

In the prior art compounds, the phenyl group corresponding to Ar₃ of compound V is unsubstituted. Moreover, the positions corresponding to R₃-R₇ substituents of compound V are either all hydrogen atoms or one or two of the substituents are NH₂, NHCH₃, NO₂, Cl or CF₃. In the claimed compounds, when Ar₃ is an unsubstituted phenyl group (like the prior art), R₃-R₇ are not NH₂, NHCH₃, NO₂, halo or CF₃ (unlike the prior art). It follows that R₃-R₇ of compound V are NH₂, NHCH₃, NO₂, halo or CF₃ only when the Ar₃ is a substituted phenyl group. Consequently, the claimed compounds are not halogen analogs or positional isomers of the prior art compounds.

Moreover, the compounds that Applicants admitted to be in the prior art are the only specifically disclosed compounds. In order to establish a *prima facie* case of obviousness over the disclosed hydrazides, there must be some suggestion or motivation to modify the compounds. *In re Grabiak*, 226 U.S.P.Q. 870 (Fed. Cir. 1985). Here, the Examiner alleges that "[t]he motivation to make these [claimed] compounds is their structural similarities to the disclosed compounds." However, the claimed compounds and the prior art compounds are not halogen analogs or position isomers of each other and, therefore, cannot be considered to be similar to each other even under the definition provided by the Examiner. Accordingly, the Examiner did not provide basis for her

assertion that the motivation to make the claimed compounds is in their structural similarities to prior art compounds. Accordingly, a *prima facie* case of obviousness of claims 1, 2, 4, 5, 8, 11 and 12 has not been established.

Reconsideration and withdrawal of the rejection of claims 1, 2, 4, 5, 8, 11 and 12 under 35 U.S.C § 103 (a) is respectfully requested.

Rejections under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 1 and 11 under 35 U.S.C § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner alleges that the newly added expression "prodrug is an ester of carboxylic acid, ... alcohol containing compounds" in claims 1, 4, 5, 8 and 11 are not enabled. Applicants respectfully traverse this rejection.

In the interest of advancing the prosecution of this application, Applicants have deleted the terms "prodrug" and "prodrugs," and the expression "prodrug is an ester of carboxylic acid, ... alcohol containing compounds" from claims 1 and 11. Reconsideration and withdrawal of the rejection of claims 1 and 11 under 35 U.S.C § 112, first paragraph, is respectfully requested.

Rejections under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claim 1 and 8 under 35 U.S.C § 112, second paragraph, as being indefinite for failing to particularly point out and distinctively claim the subject matter which applicant regards the invention. The Examiner alleges that the

expression "prodrug is an ester ... alcohol containing compounds" in claims 1 and 8 is indefinite. Applicants respectfully traverse this rejection.

In the interest of advancing the prosecution of this application, Applicants have deleted the terms "prodrug" and "prodrugs," and the expression "prodrug is an ester ... alcohol containing compounds" from claims 1 and 8. Reconsideration and withdrawal of the rejection of claims 1 and 8 under 35 U.S.C § 112, second paragraph, based on the use of the expression "prodrug is an ester ... alcohol containing compounds" in claims 1 and 8 is respectfully requested.

Priority Claim

On page 9, lines 1-6 of the Office Action, the Examiner alleges that Applicants did not comply with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. §§ 120 and 119(e). The Examiner alleges that specific reference to the prior application(s) was not provided in the first sentence(s) of the application or in an application data sheet.

Applicants assert that a priority claim in compliance with 37 C. F. R. 1.78(a)(2) requirements was made in the Application Data Sheet filed April 5, 2004, a copy of which is enclosed herein as Exhibit A. See 37 C.F.R. § 1.76(b)(5) which states that providing the domestic priority information in an Application Data Sheet constitutes the specific reference required by 35 U.S.C. §119(e) or 120, and need not otherwise be made part of the specification.

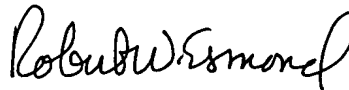
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond
Attorney for Applicants
Registration No. 32,893

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1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600
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